

Application 10/711,859  
Amendment dated July 27, 2009

Docket Number: 60052-0003

### Remarks

Applicant has reviewed the Office Action mailed on March 11, 2009. In this Supplemental Response, independent claim 47 and dependent claims 48, 49 and 50 have been canceled; claims 1, 15, 43, 44, 54-57, 66, and 67 have been amended; and dependent claims 68-72 are newly added. No new matter has been added as a result of this amendment. Claims 2, 4-9, 11, 14, 17-42, 45-46, 51-53, and 58-60 were previously canceled and claim 48 was previously withdrawn. Accordingly, claims 1, 3, 10, 12, 13, 15, 16, 43, 44, 54-57, and 61-72 remain pending in this application. No revisions are being made to the specification or the drawings.

At least for the reasons set forth below, Applicant respectfully traverses all rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicant respectfully requests reconsideration of the present application in view of the above amendment and the following remarks.

### Claim Amendments

Support for the newly added recitations of claims 1 and 54 may be found, at least, in originally filed paragraphs [0085] – [0087], and FIGS. 17 - 19.

Support for the newly added claims 69 and 70 may be found, at least, in originally filed FIG. 19. Support for the newly added claims 71 and 72 may be found, at least, in the originally filed Abstract and originally filed paragraph [0014]. Support for the newly added claims 73 and 74 may be found, at least, in the originally filed FIGS. 4B and 19, and originally filed paragraphs [0014], [0060], and [0086].

### Claim Rejections 35 U.S.C. § 112

Claims 1, 3, 10, 12, 13, 15, 16, 43, 44, and 67 were rejected under 35 U. S. C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Applicant notes that claim 1 has been amended to delete the rejected term. Accordingly, withdrawal of this rejection is respectfully requested.

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Claims 1, 3, 10, 12, 13, 15, 16, 43, 44, 47-50, and 67 were rejected under 35 U. S. C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Applicant notes that claims 47-50 have been canceled and the rejected recitation has been deleted from independent claim 1. Further dependent claim 67 has been amended to depend from claim 10 to correct the antecedent basis issue identified by the Examiner. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claim Rejections 35 U.S.C. § 103

Claims 1, 3, 10, 12, 13, 15, 16, 43, 44, 47, 49, 50, 54-57, 61-63, 66 and 67 were rejected under 35 U.S.C. § 103 as being unpatentable over Kaiya (US patent 5,178,130) in view of Torii, (US Patent 6,482,149).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out by the reference." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

If the proposed modification makes the prior art reference wholly unsuitable for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). If the proposed modification or combination of references would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In performing a 35 U.S.C. §103 analysis, it is error to consider "references in less than their entireties, i.e. in disregarding disclosures in the references that diverge from and teach away

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from the invention at hand." *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In rejecting independent claims 1 and 54, the Examiner has modified the videoscope 2b of Kaiya with the curved part 22 of the endoscope of Torii to enable the videoscope 2b of Kaiya to deflect relative to the videoscope 2a of Kaiya such that the videoscopes 2a, 2b of Kaiya take images from directions about 180 degrees apart. However, Kaiya teaches away from this modification. Further, to modify Kaiya in this manner would make the device of Kaiya wholly unsuitable for its intended purpose, as specifically prohibited in *In re Gordon*.

Specifically, Kaiya teaches two videoscopes 2a, 2b that view the same tissue from the same direction. (See Kaiya, FIGS. 2 and 10). The complexities of the invention of Kaiya are directed toward filtering the images and synchronizing sequentially the timing of taking images to prevent an identified problem where light from one videoscope reflected from tissue will deteriorate an image of the same tissue taken by the other videoscope. (Kaiya, Abstract; column 2, lines 37-48; and column 5, lines 29-37) While the teachings of Kaiya are not clear from an initial reading, a close reading of column 5, line 45 to column 7, line 53 reveals that the two videoscopes are synchronized such that a first videoscope may output green light which is reflected by tissue for a specific image of the tissue to be taken by the first videoscope, and thereafter (sequentially) the second videoscope may output red light which is reflected by the tissue for a specific image of the tissue to be taken by the second videoscope. As taught in Kaiya, this prevents an undesirable situation where the green light from the *first* videoscope is reflected by the tissue and affects the image taken by the *second* videoscope. (See specifically, Kaiya, column 7, lines 43-47). This can only be the case when, as specifically illustrated in FIGS. 2 and 10 of Kaiya, the two videoscopes are imaging the same tissue. If the videoscope 2b of Kaiya were modified such that the image of the videoscope 2b were taken in the opposite direction of the image of the videoscope 2a (i.e. not imaging the same tissue), then the modified device would be wholly unsuitable for the intended purpose of Kaiya. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Dependent claims 3, 10, 12, 13, 15, 16, 43, 44, 55-57, 61-63, 66 and 67 teach independently patentable subject matter, although they are also patentable merely by being

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dependent on an allowable base claim. As an example, claim 13 recites “a display screen for displaying the first and second images.” This recitation is not taught in the cited prior art.

Claims 30, 31, and 33-35 were rejected under 35 U.S.C. § 103 as being unpatentable over Kaiya (US patent 5,178,130) in view of Torii, (US Patent 6,482,149), and further in view of Yoon, US Patent 6,066,090.

The remarks presented above with respect to the §103 rejection are equally applicable here. Specifically, the inadequacy of Kaiya to be modified to teach the recitations of independent claim 1 is also fatal to this §103 rejection. Additionally, Yoon does not make up for the inadequacy described above. Therefore, the combination of Kaiya, Torii, and Yoon does not teach every limitation of independent claim 1, as required in *In re Royka*.

Furthermore, dependent claims, 30, 31, and 33-35, being dependent upon independent claim 1, are patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3, 10, 12, 13, 15, 16, 43, 44, 47, 49, 50, 54-57, 61, 62, and 64-67 were rejected under 35 U.S.C. § 103 as being unpatentable over Yoon, US Patent 6,066,090.

When rejecting a claim based upon a sole 35 U.S.C. 103(a) reference, the Federal Circuit has provided some guidance. Specifically, *In re Gordon* provides that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, the Federal Circuit has held that “[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure.” *In re Mills*, 16 USPQ2d 1430, 1433 (1990).

Independent claim 1 positively recites “the second lens being selectively independently advanced generally parallel to the axis relative to the first lens.” Independent claim 54 positively recites “the catheter is selectively advanced within the channel such that the rear view module is

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advanced generally along the axis relative to and independent of the first lens." In direct contrast, the endoscope branches of Yoon are taught to be advanced *simultaneously*.

Specifically, FIGS. 4 and 5 of Yoon and column 6, lines 59-66 illustrate that the endoscope branches are not independently advanced, but are simultaneously advanced in order to have each branch view the same tissue (surgical site 70) from a different perspective. If the endoscope branches of Yoon were modified so as to advance independently, then the modified device would be wholly unsuitable for the intended purpose of Yoon, as expressly prohibited in *In re Gordon*. Therefore, Yoon does not teach all recitations of independent claims 1 and 54. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Dependent claims 3, 10, 12, 13, 15, 16, 43, 44, 55-57, 61, 62, and 64-67 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. As an example, claim 57 recites "first and second wires operatively connected to the distal end of the catheter." This recitation is not taught in the cited prior art.

### Conclusion

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative. It is believed no fees are due with this response since an initial response was timely filed on June 9, 2009.

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